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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

REPLY BRIEF

Inventor : Brett A. Sneed
Serial No. : 10/068,914
Filing Date : February 7, 2002
Title : PROTECTIVE FLOORING UNIT WITH FLAP

Group/Art Unit : 1772
Examiner : Donald J. Loney

Docket No. : 504576.053

Mail Stop Appeal Brief – Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In accordance with the provisions of 37 C.F.R. § 41.41, Applicant submits this
Reply Brief in response to the Examiner's Answer mailed on April 19, 2005.

REMARKS

In the Examiner's Answer responding to Appellant's Appeal Brief, the Examiner maintains his rejection of claims 1-20 as being anticipated by any one of: U.S. Patent No. 2,512,310 to *Corson*, U.S. Patent No. 4,816,316 to *Robbins*, U.S. Patent No. 3,746,607 to *Harmon et al.*, U.S. Patent No. 4,565,725 to *Spamer et al.*, or U.S. Patent No. 5,614,288 to *Bustos*. Appellant provides the following remarks in response to the Examiner's Answer.

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I. Paragraph 10 of Examiner's Answer

In paragraph 10 of the Examiner's Answer, the Examiner states that "[w]ith respect to all of the references the appellant's argue that none of the references teach a single flap extending only from a first edge of the unit. This is not commensurate with the scope of the claims. The claims recites 'a single flap extending from the first edge.'" The Examiner further argues that the "comprising" language of the claims would allow flaps extending from any of the other edges.

Appellant respectfully disagrees. Independent claims 1, 7, and 14 of the present application all set forth (among other things):

A protective flooring unit comprising:

a main body ... (limitations on main body) ...; and

a single flap ... (limitations on single flap).

While Appellant agrees that "comprising" is generally an open term that allows inclusion of additional elements, it is not an absolute rule when, as here, the claims, specification, and prosecution history indicate that an element of the claim does not allow the inclusion of additional elements.

In *Abtox, Inc. v. Exitron Corp.*, 43 USPQ2d 1545 (Fed. Cir. 1997), a claim calling for "a chamber" for containing gas was found to be limited to a single chamber. There, the court found that while the articles "a" and "an" in a claim generally are interpreted as meaning "one or more", the claim language itself suggested a single chamber and there was no indication that the inventors intended "a chamber" to have other than its normal singular

meaning. Furthermore, the court in *Abtox* made it clear that the prosecution history of the application provides additional context for understanding the claim terms.

In *Spectrum International Inc. v. Sterlite Corp.*, 49 USPQ2d 1065 (Fed. Cir. 1998) , an applicant, during prosecution of the application, had argued that its crate differed from the cited prior art in that the claimed invention did not include a merger of the bottom side of the crate with a top edge of the front wall of the crate. After issuance of a patent and pursuing an infringer, the applicant asserted that the “comprising” term in the claim allowed reading the claim to include merger of the bottom side of the crate with a top edge of the front wall of the crate. The court, of course, found that by conceding such a crate construction during prosecution, the applicant was not able to restore that subject matter by virtue of the “comprising” term used in the claim.

Both of these cases are directly on point to the issue here. The Examiner states that the “comprising” language of independent claims 1, 7, and 14 must be construed to mean that the “single flap” limitation in the claims does not limit the scope of the claims to a protective flooring unit having only a single flap. However, Appellant maintains that, as in *Abtox*, the language of the claims anticipates only a single flap, and cannot include additional flaps as suggested by the Examiner. Even more clearly than in *Abtox*, Appellant here has amended the claims to add the word “single” to the claim language to specifically limit the scope of the claim to include only a single flap. Thus, the argument here is not just whether “comprising ... ‘a flap’” language allows the inclusion of additional flaps, the argument is whether “comprising ... ‘a single flap’” language can possibly be construed to allow the inclusion of additional flaps. Appellant believes that it cannot.

Similar to the situation in *Spectrum International*, in order to overcome the cited prior art, Appellant here has argued that the claims are directed only to a floor covering having a single flap. Appellant has even gone further and has amended the claims to specifically limit the claims to a “single flap”. As in *Spectrum International*, if attempting to enforce its claims, Appellant would clearly be limited by the claim amendments and arguments presented during prosecution to a protective flooring unit having a single flap. Appellant would not be allowed to rely on the “comprising” term to restore coverage beyond the claimed “single flap”. Thus, it is improper for the Examiner to construe the “comprising” term in the claims to allow inclusion of additional flaps as in the cited prior art. Appellant has amended and limited the claims to avoid the prior art such that any allowed claims will be limited in scope by those amendments and arguments. The Examiner should not be allowed to ignore those limitations in order to reject the claims in view of the prior art when those same limitations would prevent Appellant from enforcing its claims against the embodiments disclosed in that prior art.

II. Appellant's Claims are not Anticipated by the Cited Prior Art

As discussed above, claims 1, 7, and 14 of the present application each set forth a protective flooring unit having, among other things, a single flap extending outwardly from a first edge of a main body

Corson does not disclose a flooring unit having a single flap, as required in every claim of the present application, and does not disclose an overlapping portion and third and fourth opposing edges that approximately equal a maximum thickness of the main body, as required in every claim of the present application. Assuming the web 11 of *Corson* corresponds to the flap of the present application, FIG. 3 shows that web 11 extends from both of opposed

first and second edges of the mat. Claims 1, 7, and 14 of the present application, however, structurally limits the flooring unit to a single flap extending only from a first edge of the flooring unit. The mat disclosed in *Corson* does not have a single flap extending only from a first edge.

Robbins does not disclose a flooring unit having a single flap, as required in every claim of the present application, and does not disclose an overlapping portion and third and fourth opposing edges that approximately equal a maximum thickness of said main body, as required in every claim of the present application. Even assuming either edges 16 or 18 of *Robbins* can be considered a "flap" as described in the present application, that "flap" is present on two opposing edges of the sheet. Claims 1, 7, and 14 of the present application, however, structurally limits the flooring unit to a single flap extending only from a first edge of the flooring unit. Thus, the sheet disclosed in *Robbins* does not have a single flap extending only from a first edge.

Harmon does not disclose a flooring unit having a single flap, as required in every claim of the present application, and does not disclose an overlapping portion and third and fourth opposing edges that approximately equal a maximum thickness of said main body, as required in every claim of the present application. As shown and described in all of the variations disclosed in *Harmon*, opposing first and second edges are identical, as are opposing third and fourth edges. Claims 1, 7, and 14 of the present application, however, structurally limits the flooring unit to a single flap extending only from a first edge of the flooring unit. The sheet disclosed in *Harmon* does not have a single flap extending only from a first edge.

Spamer does not disclose a flooring unit having a single flap, as required in every claim of the present application, and does not disclose an overlapping portion and third and

fourth opposing edges that approximately equal a maximum thickness of said main body, as required in every claim of the present application. *Spamer* discloses only a track in which opposing first and second edges are identical, as are opposing third and fourth edges. Claims 1, 7, and 14 of the present application, however, structurally limits the flooring unit to a single flap extending only from a first edge of the flooring unit. The track disclosed in *Spamer* does not have a single flap extending only from a first edge.

And, finally, *Bustos* does not disclose a flooring unit having single flap, as required in every claim of the present application, and does not disclose an overlapping portion and third and fourth opposing edges that approximately equal a maximum thickness of said main body, as required in every claim of the present application. *Bustos* discloses a track in which opposing first and second edges are identical, as are opposing third and fourth edges (see FIG. 1 and 2 of *Bustos*). Claims 1, 7, and 14 of the present application, however, structurally limits the flooring unit to a single flap extending only from a first edge of the flooring unit. The track disclosed in *Bustos* does not have a single flap extending only from a first edge.

Since neither *Corson*, *Robbins*, *Harmon*, *Spamer*, nor *Bustos* disclose a protective flooring unit having “a single flap” as required in independent claims 1, 7, and 14 of the present application, those claims are not anticipated by the prior art and are allowable. Thus, the Examiner’s rejection should be reversed.

III. Dependent Claims are not Anticipated

Claims 2-6, 8-13, and 15-20 depend from independent claims 1, 7, and 14, respectively. Since claims 1, 7, and 14 are allowable for the reasons discussed above, claims 2-6, 8-13, and 15-20 are thus also allowable, and the examiner’s rejection should be reversed.

For the foregoing reasons, Applicant respectfully submits that claims 1-20 are patentable over the cited references and should be allowed. Accordingly, Applicant respectfully requests that the Board reverse the Examiner's rejections and allow claims 1-20.

Respectfully submitted,

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